

## Remarks

### The Claims

It should be noted that the claims submitted in this Substitute Amendment After Final Action are amended. Applicant respectfully believes that these amended claims overcome the Examiner's objections and rejections and place the claims in condition for allowance.

### Purpose of this RCE

The purpose of this Substitute Amendment After Final Action is to respond to the outstanding Office Action's claim rejections citing the patents to Wollermann and Koch, and to make clear that it is valid for the present application to claim priority of Swiss Application 3235/95.

### Oath/Declaration

**Applicant agrees that an RCE is a continued examination of the same application and not a "new" application. The present application is the entry into national stage of PCT/EP97/05216, filed on 23 September 1997, which is a CIP of PCT/EP96/04790, filed 4 November 1996.**

A new Declaration is submitted herewith. This new Declaration remedies the problem of the application claiming priority of itself.

In the corrected declaration, the present application claims priority of PCT/EP96/04790, filed 4 November 1996 (benefit under the "35 USC 120" portion of the Declaration - see page 2 of the Declaration), and claims priority of Swiss Applications 2329/96, filed 23 September 1996 and 3235/95 filed 6 November 1995 (benefit under the "35 USC 119" portion of the Declaration - see page 1 of the Declaration).

## Discussion of the Priority of the Present Application

### Discussion of Attachment A

**PCT/EP96/04790, filed 4 November 1996, claims priority of 3235/95, Swiss**

**Application filed 6 November 1995.** (See Attachment A cover page, field (30) where an arrow has been drawn to point out the Swiss priority application 3235/95 with the priority date of 6 November 1995).

### Discussion of Attachment B

Attachment B is a corrected front page for PCT/EP97/05216, which was published by the PCT after the paperwork was filed to enter the National Stage. The original cover page from the PCT Office for PCT/EP97/05216, submitted when this application entered the national stage, did not correctly state that **the present application, PCT/EP97/05216, is a CIP of PCT/EP96/04790.** That error has been a source of much confusion in the prosecution of this application.

**PCT/EP97/05216, filed 23 September 1997, claims priority of 2329/96, Swiss**

**Application filed 23 September 1996, and PCT/EP96/04790, filed 4 November 1996.** (See Attachment B cover page, field (30) where an arrow has been drawn to point out the Swiss priority application 2329/96 with the priority date of 23 September 1996, and PCT/EP96/04790 with the priority date of 4 November 1996).

On Attachment B, it is respectfully requested the Examiner note the left box beneath the International Classes. The translation of the German text in that box is translated below in italics.

On Attachment B, arrows have been drawn to the points currently discussed.

The first arrow is drawn to Field 30, which indicates the point relating to priority “(30) Prioritätsdaten” (*Priority Date*) and notes “2329/96” filed “23 September 1996” - “CH” (Switzerland)” and “PCT/EP96/04790” filed “4 November 1996”.

A second arrow is drawn to Field 63. Field 63 indicates the following important information. “(63) Fortsetzung (CON) oder Teilfortsetzung (CIP) der früheren Anmeldung” (*Continuation or Continuation in Part of the Earlier Application*) “US PCT/EP96/04790 (CIP)” “Angemeldet am” (*filed on*) “4 November 1996”. If the Examiner wishes for Applicant to submit a certified translation of Attachment B, one can be provided upon request from the Examiner.

#### Discussion of Attachment C

The error in the front page of PCT/EP97/05216 was corrected by the PCT Office in the following pages of the publication from the PCT Office, “PCT Gazette, Section II, Corrected Versions of Pamphlet Front Pages,” published on 24 September 1998, which is submitted herewith (See Attachment C - two pages - arrow of notation added by Applicant on page 2 of Attachment C). An arrow has been drawn to call attention to “WO 98/13907, PCT/EP97/05216”. The text on Attachment C, page 2, right column states “add INID Number (63) “Related by continuation (CON) or continuation-in-part (CIP) to earlier application” which was inadvertently omitted from the front page.”

**Attachments A and B set forth the priority for PCT/EP96/04790 and PCT/EP97/05216. As a CIP of PCT/EP96/04790, PCT/EP97/05216 properly claims priority of Swiss Application 3235/95, filed on 6 November 1995.**

Attachment C verifies that the corrected cover sheet for PCT/EP97/05216 (WO 98/13907) found in Attachment B correctly shows the present application is a CIP application of PCT/EP96/04790.

Given that the present application, PCT/EP97/05216, claims priority of Swiss Application 2329/96, and the present application is a CIP of PCT/EP96/04790, which claims priority of Swiss application 3235/95 filed 6 November 1995, the present application rightfully claims priority of Swiss Application 3235/95, filed 6 November 1995.

The corrected declaration and explanations of Attachments A, B and C verify Applicant's right to claim priority of Swiss Application 3235/95.

Comments Regarding the Drawings and Objections to Figure 33

Regarding points 6 through 10 of the Office Action concerning the drawings, Applicant submits herewith a set of proposed drawings in which the German captions are presented in English. Further, Applicant has canceled Figure 33 and canceled the portions of the specification that were amended to describe Figure 33. The Examiner never entered Figure 33 and the amendment to the Specification describing Figure 33. Therefore, this comment is merely a notation to the Examiner and no formal amendment to make these deletions to the Specification is being submitted herewith.

Applicant reserves the right to reintroduce Figure 33 and the Amendment that described Figure 33. Withdrawing Figure 33 and the associated description in the specification is without prejudice to Applicant's right to introduce the same or substantially the same or similar drawings in this or another case.

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### Claims Rejections - 35 USC 112

Claims 40, 75-82, 110-113, 115-116, and 125 were rejected as failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. The claims have been amended to clearly point out the subject matter of the claims and address the Examiner's objections. Applicant respectfully believes that this amendment overcomes the 112 (2) rejections.

### Rejections on Prior Art under 35 USC 102

#### The Patent to Tomoji

Claims 88, 39-46, 84, 89, 90, 117 and 123 are rejected as being anticipated by the Japanese Patent to Tomoji. The priority of the present application pre-dates the Japanese Patent to Tomoji, and therefore, no argument is presented regarding this citation, as it is not "prior art".

A certified translation of Swiss Application 2329/96 is submitted herewith as per the Examiner's comments set forth in numbered item 15, page 10, of the Office Action of November 22, 2002.

#### The Patent to Wollermann

Claims 39, 41-49, 59-75, 81, 84, 85, 88, 89, 100-113, 115-118 and 121-123 were rejected as being anticipated by Wollermann et al. (Wollermann)

Valid rejection under 35 USC 102 requires that each feature of a rejected claim be disclosed in a single reference. "For anticipation under 35 USC 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present." MPEP 706.02(a).

Wollermann does not disclose each feature of the rejected claims of the present invention.

Amended independent claim 88 of the present invention recites:

A continuous cable insulation stripping apparatus with a transport path along which a cable may be transported, wherein **said transport path is parallel to the axis of a cable to be transported along said transport path**, comprising at least one tool, at least one tool support, and a **positioner that relatively positions the at least one tool support in a direction perpendicular to a working direction of the at least one tool and perpendicular to a parallel transport path** wherein said positioner positions said at least one tool support to more than two positions. (Emphasis added)

#### Wollermann's Invention

Wollermann's tool holders are not transportable laterally to the transport path. The Examiner defined **Wollermann's transport path as the path along which the cables (cable sections) are transported. This means that the transport path is perpendicular to axis of the cable.** According to the Examiner, Wollermann's transport path can be seen as a dotted line, above which an arrow is pointing to the right (see Wollermann's Figure 2). In Wollermann's Figure 2, one can see the cables 18 are perpendicular to the transport path, and one can further see **Wollermann's tool holders (for example, 122B) are about parallel to the transport path.** Better seen in Figure 1, Wollermann's tool holders can be moved along a circle in and out of the transport path. Wollermann's tool holders are therefore more or less parallel to the transport path, movable, but not perpendicular to it.

Amended claim 39 better emphasizes these distinctions between Wollermann and the present invention, and amended claim 88 further distinguishes that **the present invention's transport path is about parallel to the axis of the cable, whereas in Wollermann the transport path is perpendicular to the axis of the cable. Wollermann's tools are shifted in line to the transport path of the cable, and not laterally to the cable.**

In Wollermann, the **cable is moved to more than two positions** in a direction perpendicular to a working direction of the at least one tool - **but the tool is not moved**. This is a significant difference from the present invention. In **Wollermann**, one needs **many different tools and drives for each different tool**, whereas the **present invention has only one drive for all tools on the tool support**. Nonetheless, the **present invention can do many different operations on the one cable (as Wollermann does)**.

With respect to claim 77 of the present application, Applicant requests the Examiner note that according to the present invention, the plane in which the gripping jaws lie is perpendicular to a transport path. In contrast, in Wollermann, the gripping jaws lie in a plane parallel to the transport path.

Regarding claim 103, Applicant requests the Examiner note that **Wollermann's transporters must move, because otherwise the cable sections would not be moved**.

In contrast, the **transporters of the present invention are in a spatially fixed relationship with respect to the processing station**. The transporters of the present invention cannot be moved closer or further from the processing station along the direction of the transport path.

#### Claim Rejections under 35 USC 103

##### Claim Rejection on the Basis of Wollermann in view of Koch

Claims 87, 120, and 125 are rejected under 35 USC 103 as being unpatentable over Wollermann '926 as applied to claims 88 and 39, and further, in view of Koch '598.

Valid rejection under 35 USC 103(a) requires evidence of a suggestion or motivation for one skilled in the art to combine prior art references to produce the claimed invention. US Court

of Appeals for the Federal Circuit (*Ecolchem inc. v Southern California Edison Co., Fed. Cir.*, No. 99/1043, 9/7/00).

**Wollerman and Koch** do not motivate or suggest to one skilled in the art to combine these references to produce Applicant's claimed invention.

Recently, in *In Re Sang-Su Lee* (00-1158) the Court of Appeals for the Federal Circuit rendered a decision confirming the above principles. The court analyzed 35 USC 103 requirements starting from the Administrative Procedure Act and held (citations omitted):

"Tribunals of the PTO are governed by the Administrative Procedure Act, and their rulings receive the same judicial deference as do tribunals of other administrative agencies.

"The Administrative Procedure Act, which governs the proceedings of administrative agencies and related judicial review, establishes a scheme of "reasoned decision making." Not only must an agency's decreed result be within the scope of its lawful authority, but the process by which it reaches that result must be logical and rational.

"As applied to the determination of patentability vel non when the issue is obviousness, it is fundamental that rejections under 35 USC §103 must be based on evidence comprehended by the language of that section. (Emphasis added). When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. (Emphasis added)

"The factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. Our case law makes clear that the best defense against

the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. There must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the Applicant. Teachings of references can be combined only if there is some suggestion or incentive to do so.”

As stated above, **Wollermann and Koch do not motivate or suggest to a person skilled in the art to combine these references to duplicate the claims of the present invention.**

Independent claim 88 is not anticipated by Wollermann and independent claim 88 is not made unpatentable by the combination of Wollermann and Koch. Independent claim 88 recites:

“A continuous cable insulation stripping apparatus **with a transport path along which a cable may be transported, wherein said transport path is parallel to the axis of a cable to be transported along said transport path,** comprising at least one tool, at least one tool support, and a positioner that relatively positions the at least one tool support in a direction perpendicular to a working direction of the at least one tool **and perpendicular to a parallel transport path** wherein said positioner positions said at least one tool support to more than two positions.” (Emphasis added).

Neither Wollermann nor Koch have such a feature.

As stated previously, in Wollermann, **the cable is moved to more than two positions** in a direction perpendicular to a working direction of the at least one tool - **but the tool is not moved.** This is a significant difference from the present invention. In **Wollermann, one needs many different tools and drives for each different tool,** whereas the **present invention has**

**only one drive for all tools on the tool support. Nonetheless, the present invention can do many different operations on the one cable (as Wollermann does).**

Applicant respectfully disagrees with the Examiner's suggested combination of Wollermann and Koch.

**Wollermann is a different type of device that cannot be compared or combined with Koch, because of Wollermann's "dead end".** The Examiner's attention is called to Wollermann's Figures 5 and 6, which show that a "dead end" that moves back and forth. At least, Wollermann's piece 43 stops the cable when the tool is moved onto the cable. Additionally, the Examiner's attention is called to Wollermann's Figure 11. This Figure shows Wollermann's transport paths of the cable. The first transport path of the cable is perpendicular to the second transport path of the cable. The cable is stiff in its length of the axis. The tools are moving back and forth onto the cable.

For a person of ordinary skill in the art, it would not be clear where Koch's belt drive should be mounted in Wollermann's device. To the best of Applicant's belief, such integration would not be possible, even if retrospectively considered, at least because **Koch has a transport path that is parallel to a cable, whereas Wollermann has a transport path that is perpendicular to a cable,** as the Examiner states with respect to Wollermann's Figure 2.

On the other hand if Koch would be integrated, instead of what Wollermann provides for holding the cables at the cable ends, when the cable sections are transported along Wollermann's transport path, Wollermann's cable would be perpendicular to the plane in which the bends of Koch lie, namely the plane of the drawing. Then at least parts 19, 25, 17 and 20, would not allow such transport and would hinder a cable to pass.

Koch only allows transporting cable in line with the plane along a transport path that is between the two bands. The Examiner's attention is drawn to Koch's Figures 1-3, in which the cable is moved along its transport path back and forth.

For that reason the combination of Wollermann and Koch cannot work, and a man skilled in the art would not combine the teachings of Wollermann and Koch.

A combination of Wollermann with Koch would not bring a person of ordinary skill in the art closer to the present invention, as described in Claim 88.

#### Allowable Subject Matter

Claims 80 and 82 would be allowable if they were written to overcome the Rejections under 35 USC 102 set forth in the Office Action and to include any limitations of the base claim and intervening claims. New claims 132 and 133 rewrite claims 80 and 82 in independent form and therefore should be allowable.

Applicant respectfully believes that independent claims 39 and 88, as amended, should be allowable, and hence, if the new independent claims are allowable, the claims depending upon the allowable independent claims should be allowable, also.

This Substitute Amendment After Final Action is necessary to place the claims in better condition for allowance or appeal. It is anticipated that the amendment to the claims, and arguments presented herein, should place this case in condition for allowance.

In a separate document submitted with this Amendment After Final Action, we have submitted a Petition to Revive the present application for Unintentional Abandonment, as well as an RCE to request this Substitute Amendment After Final Action be entered and examined.

Wherefore further consideration and allowance of the claims in this application as amended is respectfully requested.

The following are submitted herewith:

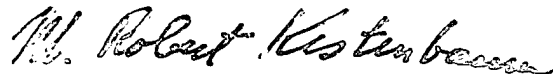
- A Petition to Revive for a Patent Abandoned Unintentionally Under 37 CFR 1.137(b)
- Substitute Amendment After Final Action
- New Inventor's Declaration
- Set of proposed drawings in which the text is in English
- Certified translation of Swiss Application 2329/96
- A "Petition for Extension of Time Under 37 CFR 1.136(a) - three months"
- A Request for Continued Examination requesting this Substitute Amendment After Final Action be entered and examination continue on the basis of the claims set forth in this Substitute Amendment After Final Action
- A PTO Form 2038 authorizing charging to a credit card the following fees for this submission. The fees to be charged are set forth on the following page.

Fees to be charged to the PTO Form 2038:

- \$650 Petition to Revive Fee
- \$465 three-month entity extension fee to pay for the extension of time to respond to the outstanding November 22, 2002 Final Office Action
- \$45 fee for the submission of the five new dependent claims introduced in this Substitute Amendment After Final Action
- \$375 RCE fee
- The above fees total \$1,535. This delineation of fees and the PTO 2038 should cover payment of all of the fees. It is noted that this delineation of fees are separately set forth in the respective Petition to Revive, Petition for Extension of Time, and RCE, and there should be no duplication of charging to the credit card.

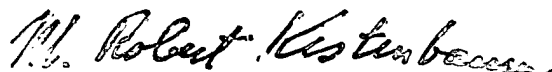
Any other fees or refunds due by virtue of this filing or this application should be charged to Deposit Account 11-0665. A duplicate of this page is enclosed for this purpose.

Respectfully submitted,



M. Robert Kestenbaum  
Reg. No. 20,430  
11011 Bermuda Dunes NE  
Albuquerque, NM USA 87111  
Telephone (505) 323-0771  
Facsimile (505) 323-0865

I hereby certify this correspondence is being deposited with the US Postal Service as Express Mail in an envelope with sufficient postage to Mail Stop Petition, PO Box 1450, Commissioner for Patents, Alexandria, VA 22313-1450 on September 22, 2003, Express Mail Label No. EU964783968US.



M. Robert Kestenbaum

PCT

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Internationales Büro

INTERNATIONALE ANMELDUNG VERÖFFENTLICHT NACH DEM VERTRAG ÜBER DIE  
INTERNATIONALE ZUSAMMENARBEIT AUF DEM GEBIET DES PATENTWESENS (PCT)

ATTACHMENT A

|   |  |   |  |
|---|--|---|--|
| (51) Internationale Patentklassifikation <sup>6</sup> :<br>H02G 1/12  |  | A1  | (11) Internationale Veröffentlichungsnummer: WO 97/17751 |
|   |  | (43) Internationales<br>Veröffentlichungsdatum:   | 15. Mai 1997 (15.05.97)                                  |
| (21) Internationales Aktenzeichen: PCT/EP96/04790   |  | (81) Bestimmungsstaaten: BR, JP, KR, US, europäisches Patent<br>(AT, BE, CH, DE, DK, ES, FI, FR, GB, GR, IE, IT, LU, MC, NL, PT, SE). |  |
| (22) Internationales Anmeldedatum: 4. November 1996 (04.11.96)  |  |   |  |
| (30) Prioritätsdaten:<br>3235/95 6. November 1995 (06.11.95) CH   |  | Veröffentlicht<br>Mit internationalem Recherchenbericht.  |  |
| (71) Anmelder (für alle Bestimmungsstaaten ausser US): SCHLEUNIGER HOLDING AG [CH/CH]; Glutz-Blotzheim-Strasse 3, CH-4502 Solothurn (CH). |  |   |  |
| (72) Erfinder; und<br>(75) Erfinder/Anmelder (nur für US): LOCHER, Beat [CH/CH]; Schleuniger AG, Biergutstrasse 9, CH-3608 Thun (CH).     |  |   |  |
| (74) Anwalt: PATENTBÜRO BÜCHEL & PARTNER AG; Letzanaweg 25-27, FL-9495 Triesen (LI).  |  |   |  |

(54) Title: INSULATION STRIPPING DEVICE

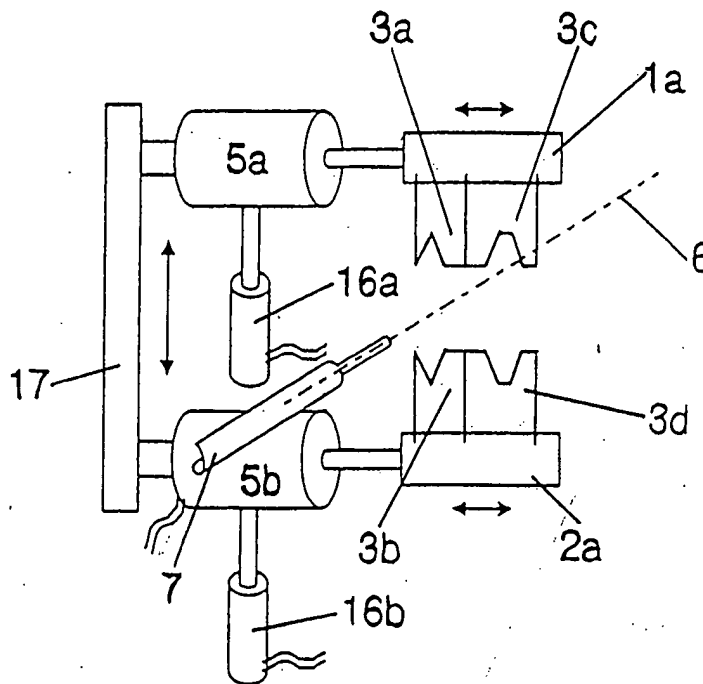
(54) Bezeichnung: ABISOLIERVORRICHTUNG

(57) Abstract

The invention concerns a novel insulation stripping device with continuously adjustable tool carriers (1, 2) disposed perpendicular relative to the cable feed direction such that a plurality of tools (3) can be placed in any positions so that any work can be carried out on cables (7). The invention further concerns various novel methods and improved devices.

(57) Zusammenfassung

Die Erfindung betrifft eine neuartige Abisoliervorrichtung mit stufenlos verstellbaren Werkzeugträgern (1, 2) senkrecht auf die Kabelvorschubrichtung, so dass mehrere Werkzeuge (3) beliebig positionierbar sind und derart Kabel (7) universell bearbeitet werden können. Verschiedene neue Verfahren und verbesserte Vorrichtungen sind ergänzend angegeben.



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INTERNATIONALE ANMELDUNG VERÖFFENTLICHT NACH DEM VERTRAG ÜBER DIE  
INTERNATIONALE ZUSAMMENARBEIT AUF DEM GEBIET DES PATENTWESENS (PCT)

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H01R 43/05, H02G 1/12

A1

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(22) Internationales Anmeldedatum: 23. September 1997  
(23.09.97)

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2329/96 23. September 1996 (23.09.96) CH  
PCT/EP96/04790 4. November 1996 (04.11.96) WO

(34) Länder für die die regionale oder  
internationale Anmeldung eingereicht  
worden ist: BR usw.

*Continuation or Continuation in Part  
of the*

(63) Fortsetzung (CON) oder Teilfortsetzung (CIP) der  
früheren Anmeldung *earlier application*  
US PCT/EP96/04790 (CIP)  
Angemeldet am 4. November 1996 (04.11.96)

*filed on*

(71) Anmelder (für alle Bestimmungsstaaten ausser US): SCHLEU-  
NIGER HOLDING AG [CH/CH]; Glutz-Blotzheim-Strasse  
3, CH-4502 Solothurn (CH).

(72) Erfinder; und

(75) Erfinder/Anmelder (nur für US): LOCHER, Beat [CH/CH];  
Blerigustrasse 9, CH-3608 Thun (CH). STEPAN, Jiri  
[CH/CH]; St. Gallenstrasse 76, CH-9320 Sargans (CH).

(74) Anwalt: ROSENICH, Paul; Patentbüro Büchel & Partner AG,  
Letzanaweg 25-27, FL-9495 Trüben (LI).

(81) Bestimmungsstaaten: BR, JP, KR, US, europäisches Patent  
(AT, BE, CH, DE, DK, ES, FI, FR, GB, GR, IE, IT, LU,  
MC, NL, PT, SE).

Veröffentlicht

Mit internationalen Recherchenbericht.  
Vor Ablauf der für Änderungen der Ansprüche eingeschrittenen  
Frist. Veröffentlichung wird wiederholt falls Änderungen  
eintreffen.

THIS IS AN  
ENGLISH TRANSLATION OF  
THE GERMAN TEXT IN  
FIELD (63).

(54) Title: CONTINUOUS CABLE PROCESSING DEVICE

(54) Bezeichnung: ENDLOSKABELBEARBEITUNGSVORRICHTUNG

(57) Abstract

The invention concerns a continuous cable processing device to produce cable sections (107a, b) with processed ends having a cable feeding device with at least one transporting device (A, B; C; 111; 112, 113) to move and hold the cable (107) in an axial direction and crosswise to it a cutting station (E, F, G, 115). According to a special variant, two transporting devices (A, B; C; 111; 112, 113) are placed on both sides of the cutting station (E, F, G, 115) running in the longitudinal direction of the cable, each of them holding the resulting respective end sections of the cable (107 a, b) in its same direction and in a movable position after the cable has been cut (107). At least one of the end processing stations (16, 17) is placed alongside the transporting devices (A, B; C; 111; 112, 113) running crosswise with respect to the direction of the cable and allowing it to move, so that one end section of the cable can be inserted in the end processing station (16, 17).

(57) Zusammenfassung

Eine Endloskabelbearbeitungsvorrichtung zum Erzeugen von Kabelteilstücken (107a, b) mit bearbeiteten Enden umfasst eine Kabelfördervorrichtung mit zumindest einer Transporteinrichtung (A, B; C; 111; 112, 113) zum Bewegen und Halten des Kabels (107) in axialer Richtung und quer dazu eine Messerstation (E, F, G, 115). Gemäss einer speziellen Variante sind zwei Transporteinrichtungen (A, B; C; 111; 112, 113) in Kabellängsrichtung beidseits der Messerstation (E, F, G, 115) angeordnet und halten nach dem Durchtrennen des Kabels (107) je einen der beim Trennen erzeugten Kabelendbereiche (107a, b) in Kabellängsrichtung bewegbar. Zumindest eine dieser Endbearbeitungsstationen (16, 17) ist quer zur Kabellängsrichtung neben der Messerstation (E, F, G, 115) angeordnet und zumindest eine Transporteinrichtung (A, B; C; 111; 112, 113) ist quer zur Kabellängsrichtung bewegbar, so dass ein Kabelendbereich der Endbearbeitungsstation (16, 17) zuführbar ist.

